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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,044	10/24/2001	James B. Andreyka	F-249	5155

919 7590 12/11/2003

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EXAMINER

SCHLAK, DANIEL K

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/004,044

Applicant(s)

ANDREYKA ET AL.

Examiner

Daniel K Schlak

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-11 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of the restriction between Groups I and II in Paper No. 6 is acknowledged.

Group II, claims 12-14, have been removed from consideration.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,441,248 to Kristola.

Applicant is directed specifically to figures 4-6, wherein, Kristola teaches an inner cylinder (60) with an outer periphery, a cutout region (to which 110 is connected), and an air passageway communicating with the cutout region and with an air pressure device, an outer cylinder (80) concentrically mounted on the outer periphery of the inner cylinder for rotation, wherein the outer cylinder comprises at least one opening (90) communicating with the cutout region and wherein the opening is adjacent the pickup point while the outer cylinder is rotated relative to the inner cylinder (if someone were to turn or twist the outer cylinder relative to the inner cylinder, the opening would be

Art Unit: 3653

adjacent the pickup point – applicant is reminded that this is functional language, recited indirectly via the “when said at least one opening is adjacent...” recitation and not positively stated as being of the working features of the device). Kristola further teaches a vacuum shoe positioned on an outer surface of the outer cylinder, the shoe having an aperture communicating with the opening such that when the opening is adjacent to the pickup point, the negative pressure at the aperture causes the item to become attached to the shoe, allowing the pneumatic apparatus to move the item away from the pickup point; and means for removably securing the vacuum shoe to the outer cylinder, wherein the means are screw with holes, and wherein the vacuum shoe is capable of removal for maintenance or replacement.

Applicant is further reminded that claim 1 recites *no more* than the shoe itself, all recitations to the inner and outer cylinders, and what they might or might not be capable of doing, being intended use only.

In the copy of Kristola which accompanies this action, the Examiner has labeled pertinent features to assist Applicant in understanding the nature of the rejection.

***Allowable Subject Matter***

Claims 5-11 are allowed.

Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3653

Kristola does not teach means for rotating the outer cylinder relative to the inner cylinder.

Of the references which teach means for rotating an outer cylinder relative to an inner cylinder, each was found to omit either one or the other of the following two features;

a) a means for attaching a respective shoe to the outer cylinder, wherein the means, interpreted within the language of 35 U.S.C. 112 6<sup>th</sup> paragraph, was/were equal to or equivalent to the screws and holes of the disclosure of the instant application, and

b) the outer cylinder concentrically mounted on the outer periphery of the inner cylinder for rotation.

Examples of (a) are:

JP 63-66043, which does not mention the means by which 4 is attached to 3 (for this reference, the Examiner obtained an on-the-spot translation, wherein he was informed that figure 4 is prior art and the discussion of it is very limited, omitting any details of the means for attaching 4 to 3; and

US 4,345,752, which recites that the shoes are merely "coverings" and gives no mechanical means for attaching them.

Examples of (b) are US 3,005,565 and US 3,372,924, both of which teach the smaller cylinder next to the larger cylinder, and therefore not concentric therewith.

In all, the particular combinations of claims 3 and 5 were simply not found to reside completely within the same reference. Although myriad combinations of

Art Unit: 3653

references could have been made under 35 U.S.C. 103, there is no motivation for doing so.

### ***Conclusion***

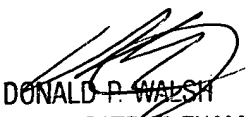
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is 703-306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

dks

  
DONALD P. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600